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Koichiro Tani

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOICHIRO TANI

Appeal 2009-007488
Application 10/673,258
Technology Center 3700

Before JENNIFER D. BAHR, LINDA E. HORNER and
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

1 The Appellant appeals under 35 U.S.C. § 134 from the decision of the
2 Examiner finally rejecting claims 1, 3-5, 7-10, 12, 13, 15, 17, 19, 20 and 22-
3 26. The Examiner rejects each of these claims under 35 U.S.C. § 103(a) as
4 being unpatentable over Robles (US 6,004,306, issued Dec. 21, 1999). We
5 have jurisdiction under 35 U.S.C. § 6(b).

6 We REVERSE.

7 Claims 1 and 24 are independent. Claim 1 recites:

8 1. A disposable diaper, comprising:

9 a diaper body having a top sheet, a back
10 sheet, and an absorbent body enclosed between the
11 top sheet and the back sheet;

12 a pair of side flaps fixed to the diaper body;
13 and

14 a pair of fasteners;

15 wherein the diaper body further has a pair of
16 side edges extending in a longitudinal direction of
17 the diaper body;

18 wherein each of the side flaps extends in a
19 width direction of the diaper body and has an inner
20 end being disposed inboard of a respective one of
21 the side edges of the diaper body and an outer end
22 being disposed outboard of the respective side
23 edge of the diaper body, and each of the fasteners
24 is fixed to the outer end of one of the side flaps;
25 and

26 wherein each of the side flaps is fixed to the
27 diaper body at

28 a fixing part being arranged adjacent
29 and along an inner edge of the inner end of
30 the respective side flap,

1 a first joint part located at an upper
2 part of the inner end of the respective side
3 flap, and

4 a second joint part located at a lower
5 part of the inner end of the respective side
6 flap, the lower part being spaced in the
7 longitudinal direction from the upper part,
8 and the fixing part being spaced, in the
9 width direction of the diaper body, from the
10 joint parts by a bonding-free region in which
11 the side flap is free of direct attachment to
12 the diaper body; and

13 wherein a pulling force, which occurs when
14 the fastener fixed to each of the side flaps is pulled
15 transversely outwardly in use, is dispersed into
16 first and second tensile forces directed towards the
17 first and second joint parts, respectively, and
18 concentrated around leg and waist openings of the
19 diaper for enhanced fit of the diaper on a wearer in
20 use.

21 Claim 24 also recites a disposable diaper including side flaps. Each of
22 the side flaps is fixed to the diaper body at a fixing part being arranged
23 adjacent and along an inner edge of the inner end of the respective side flap,
24 a first joint part located at an upper part of the inner end of the respective
25 side flap, and a second joint part located at a lower part of the inner end of
26 the respective side flap. The fixing part is spaced, in the width direction of
27 the diaper body, inwardly from the joint parts by a bonding-free region in
28 which the side flap is free of direct attachment to the diaper body.

29 Claims 15 and 17 each recite methods of adjusting fitting of a
30 disposable diaper about a waist and legs of a wearer. The preambles of
31 claims 15 and 17 recite performing the methods on diapers “wherein an
32 inner end of the side flap is fixed to an inner portion of the diaper body, and

1 either or both of a side edge upper end area and a side edge lower end area
2 of the side flap are joined to the diaper body at an outer portion of the diaper
3 body, the outer portion being spaced in a width direction of the diaper body
4 from the inner portion.”

5 Ordinarily, all words in a claim must be considered in determining
6 whether the subject matter of the claim would have been obvious. *In re*
7 *Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). “Where a patentee defines a
8 structurally complete invention in the claim body and uses the preamble only
9 to state a purpose or intended use for the invention,” however, the preamble
10 may not limit the claim. *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*,
11 289 F.3d 801, 808 (Fed. Cir. 2002)(quoting *Rowe v. Dror*, 112 F.3d 473,
12 478 (Fed. Cir. 1997)). Claims 15 and 17 each use both their preamble and
13 their claim body to define their respective methods. The body of each claim
14 includes steps expressly performed on the side flaps, first joint part and
15 second joint part recited in that claim’s preamble. Since the structural
16 language in the preamble of claim 15 and claim 17 is “necessary to give
17 meaning to the claim and properly define” the claimed subject matter, claims
18 15 and 17 are limited to methods performed on the structures recited in their
19 preambles. *See Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888,
20 896 (Fed. Cir. 1984).

21 Robles discloses a disposable diaper. (Robles, col. 4, ll. 9-11.)
22 Robles’ disposable diaper includes side flaps or extensible side panels 30.
23 Each of Robles’ side panels 30 includes a waist panel 36 and a thigh panel
24 38. (Robles, col. 4, ll. 49-53; col. 12, ll. 21-31; and fig. 1.) Robles describes
25 the waist panels 36 as providing “tension around the wearer’s waist” and the

1 thigh panels 38 as maintaining “a dynamic fit around the leg of the wearer.”
2 (Robles, Abstract.)

3 Robles further describes the extensible side panels 30 as being
4 disposed adjacent one longitudinal edge 56 of the diaper body or
5 containment assembly 22. (Robles, col. 12, ll. 53-55.). Proximal edges 80
6 of the side panels 30 are joined to either the top sheet 24 of the diaper body;
7 the back sheet 26 of the diaper body; or both. (Robles, col. 12, ll. 55-67.)
8 Robles describes side panels 30 as being joined to the diaper body 20 by
9 attachment means including intermittent bonding using adhesive, dynamic
10 mechanical bonding or other known methods. (Robles, col. 13, ll. 4-13.)
11 Neither the Examiner nor the Appellant appear to identify any further
12 relevant description by Robles of the bonds formed between the extensible
13 side panels 30 and the diaper body 22.

14 The Examiner finds that the bonds formed between the extensible side
15 panels 30 and the diaper body 22 described by Robles constitute at least first
16 and second joint parts recited in the independent claims. (Ans. 3.) The
17 Examiner concedes that Robles does not explicitly teach side flap fixing
18 parts separate from the first and second joint parts recited in the claims.
19 (Ans. 4). Nevertheless, the Examiner concludes that the combination of the
20 side flap fixing part, the first joint part and the second joint part recited in
21 the independent claims fails to patentably distinguish the claimed subject
22 matter from the intermittent bonds taught by Robles. (Ans. 10.)
23 Alternatively, the Examiner concludes that it would have been obvious “to
24 place one of the fixing part and joint part inwardly of the other,” based on a
25 finding that “Robles teaches varying the positions and dimensions of the
26 bonding areas so as to effect a different fit for the user.” (Ans. 4.)

1 The passages cited by the Examiner do not support the Examiner's
2 finding that "Robles teaches varying the positions and dimensions of the
3 bonding areas so as to effect a different fit for the user." (Ans. 4.) Column
4 12, lines 24-31 and column 23, lines 32-43 of Robles do not support the
5 Examiner's finding that Robles teaches varying the positions and dimensions
6 of the bonding areas. Column 12, lines 24-31 do not address the bonding of
7 the extensible side panels 30 to the diaper body 22. Column 23, lines 24-31
8 addresses bonds formed within the waist panels 36 and the thigh panels 38
9 of the side panels 30 rather than bonds formed between the extensible side
10 panels 30 and the diaper body 22. Even assuming that the general teaching
11 found by the Examiner would imply the obviousness of the particular
12 arrangement of fixing and joint parts recited in claims 1 and 16, the
13 Examiner has not adequately shown that Robles made such a teaching.

14 Robles' description of the side panels 30 as being joined to the diaper
15 body 20 by attachment means including intermittent bonding (Robles, col.
16 13, ll. 4-13) does not imply that any part of any intermittent bond formed
17 between any side panel 30 and the diaper body 22 is spaced in a *width*
18 direction of the diaper body relative to any other part of the intermittent
19 bond. The Examiner has not articulated a rational underpinning for the
20 conclusion that the structure limiting independent claims 1, 15, 17 and 24 as
21 a whole would have been obvious. We do not sustain the rejection of claims
22 1, 3-5, 7-10, 12, 13, 15, 17, 19, 20 and 22-26 under § 103(a) as being
23 unpatentable over Robles.

1 DECISION

2 We REVERSE the Examiner's decision rejecting claims 1, 3-5, 7-10,
3 12, 13, 15, 17, 19, 20 and 22-26.

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5 REVERSED

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9 Klh

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